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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/057,261      | 04/08/1998  | TIMOTHY P. O'HAGAN   | TELNP0157US         | 6228             |

23623 7590 12/14/2001

AMIN & TUROCY, LLP  
1900 EAST 9TH STREET, NATIONAL CITY CENTER  
24TH FLOOR,  
CLEVELAND, OH 44114

EXAMINER

KNEPPER, DAVID D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2645

DATE MAILED: 12/14/2001

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/057,261

Applicant(s)

O'HAGAN, TIMOTHY P.

Examiner

David D. Knepper

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001 (CPA request).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-18,20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

1. Applicant's correspondence filed on 27 November 2001 (paper #16) has been received and considered. Claims 1, 2, 4, 5, 8-18, 20 and 22 are pending. The applicant canceled claims 3, 6, 19 and 21.

### Claims

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 8-18, 20 and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Barclay (5,960,399).

A "host computer", "mobile terminal", "dictionary file and syntax file" are anticipated by Barclay because these items are taught by Barclay's use of vocabularies and grammars (col. 3, lines 16-17). HTTP and/or TCP/IP are the notoriously well known protocols upon which to share information between host and user relied upon by internet browsers such as Netscape Navigator® as used by Barclay in column 2, line 61 (or as Barclay says, client, see figures 1, 4 and 6).

It is noted that Barclay does not anticipate "a GUI display file having attached thereto at least one of a dictionary file and syntax file . . . content specific to the GUI display file". However, he teaches that this is prior art technology performed by an Internet based speech

recognition system called SAM which requires the speech recognizer software to reside at the client . . . the grammar is, in effect distributed and downloaded when a Web page for specific topics is entered . . . the vocabularies and grammars are small. This teaches that it was well known prior to 1996 to provide small grammars and vocabularies, which are specific to a GUI such as, are commonly known to exist on a web page for interaction at remote locations through common TCP, IP and HTTP protocols. It would have been obvious for a person having ordinary skill in the pertinent art, at the time the invention was made, to combine the limited capability of SAM noted above with the system of Barclay because Barclay explicitly teaches that he can perform speech recognition. Barclay improves upon such a limited system by also allowing speaker recognition but explains in his background sufficiently that one of ordinary skill in the art would know that a simplification such as using limited vocabulary (dictionary) and syntax (grammar) specific to a GUI would only yield expected results that are well known in the art.

#### Comments

4. The new claim language related to using phonemes to specify words is explicitly taught by Barclay in column 2, lines 9-29 where he indicates the use of connected phonemes representing continuous speech and that phonetic word models are constructed using Hidden Markov Models (HMM's). The argument on page 6 that such a decoding of words using phonemes is not taught by Barclay is clearly false based on his explicit use of HMM to model words using phonemes. One of ordinary skill in the art of speech recognition would be intimately familiar with such a notoriously well-known method of modeling speech.

The argument that Barclay teaches away from storage at the remote device being limited

to mitigate such storage is not true. Barclay's device teaches that if a user desires a larger vocabulary, then it can be supplemented by allowing data to be "streamed" between remote locations such that the additional dictionaries, syntax and related word models may essentially be shared among multiple locations. However, this teaching still renders it obvious to keep a limited vocabulary at the client machine.

The explicit mention of the SAM (Speech Aware Multimedia) system indicates that such use of small vocabulary and grammars is known prior art. Thus, the improvement of Barclay to allow larger vocabularies to be shared through a streaming process, does not negate the fact that it is well known that limited vocabularies can be implemented on individual systems. In fact, common sense dictates that the more limited the vocabulary, the less resources a system would require to include storage, processing power, etc. Thus, one of ordinary skill in the art reading Barclay would recognize that the applicant's invention would be considered prior art having limited vocabularies and grammars, which are downloaded, based on specific Web page topics. As much is taught by Barclay in column 3, lines 5-12.

#### **Prior Art**

5. An article dated 27 September 1996 indicates that SAM software was released by Texas Instruments, Inc.

Another article dated 20 October 1998 indicates that similar software called SPOT (Speech On The web <sup>TM</sup>) was released by MACH<sup>+</sup> technologies.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

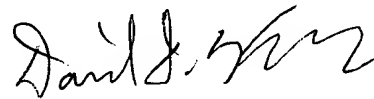
**or faxed to:**

TC2600 Fax Center  
(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (703) 305-9644. The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.



David D. Knepper  
Primary Examiner  
**Art Unit 2645**  
December 12, 2001